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NO. 3993 P. 1

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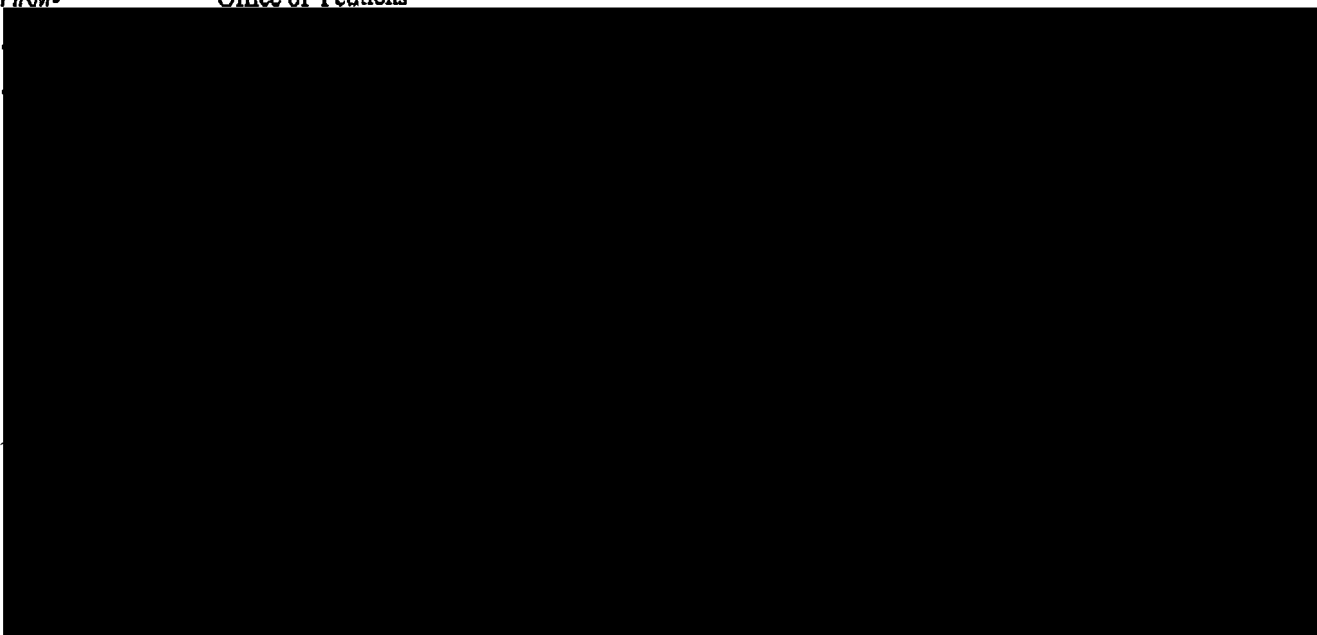
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Subject USPTO Decision dismissed our petition under 37 CFR 1.55 because (1) "the instant application does not contain a proper benefit claim under 35 U.S.C. 120 and 37 CFR 1.78(a)(2) to U.S. application 09/023,057" (the "grandparent application"), and (2) while also treating our petition as a petition under 37 CFR 1.78 to accept an unintentionally delayed claim under 35 U.S.S. 120, found the petition, so treated, to be defective.

Reconsideration of this decision is appropriate because the decision retroactively applies MPEP provisions published after the instant application was filed, and disregards the announced USPTO practice, 12/28/01 66 FR 67087 Comment 2 Response.

First, applicants note that the Decision appears to ground its dismissal of our petition on provisions of MPEP 201.11 (III)(A) that post-date the filing of the instant application. Applicants submit that the language cited in the Decision was first introduced to the MPEP in February 2003, eighteen months after the instant application was filed, and identifies new requirements not stated in the MPEP version(s) of 2001. [compare pages 200-67 through 200-70 of Feb 2003 MPEP with pages 200-66 through 200-69 of Aug. 2001 MPEP]

Second, although the first sentence of the instant application's specification was inartfully written, inasmuch as the reference to the grandparent application does not unambiguously define its relationship to the instant application, the nature of that relationship has been evident to the USPTO and to the public since at least the instant application's publication date of 12/27/01 by way of at least the following:

- (1) the USPTO's Bibliographic Data Sheet (Attachment 1)
- (2) the application as published 12/27/01 (cover, item (63)) (Attachment 2)
- (3) PAIR's continuity database (Attachment 3)
- (4) The face of the issued "parent" patent U.S. 6,317,832 (issued 11/13/01) (Attachment 4)

Given that the published relationship information properly corrected any ambiguity in the instant application as filed, applicants had no reason to believe that the benefit claim under 35 U.S.C. 120 required correction, particularly in light of the announced Office policy, id.:

"The Office has adopted the following practice: if an applicant includes a claim under § 1.78 to the benefit of a prior-filed application elsewhere in the application, but not in the manner specified in § 1.78(a)(2)(i) and (iii) or § 1.78(a)(5)(i) and (iii), within the time period set forth in § 1.78(a)(2)(ii) or § 1.78(a)(5)(ii), respectively, the Office will not require a petition (and the surcharge under § 1.17(t)) to correct the claim if the information concerning the claim contained elsewhere in the application was recognized by the Office as shown by its inclusion on a filing receipt (not as shown by its inclusion in the patent application publication). The reason for this practice is to avoid the situation in which an applicant is required to file a petition (and pay the surcharge under § 1.17(t)) even though the application was scheduled for publication on the basis of the information concerning the claim contained elsewhere in the application, but not in the manner specified in § 1.78(a)(2)(i) and (iii) or § 1.78(a)(5)(i) and (iii), within the time period set forth in § 1.78(a)(2)(ii). That is, whether an applicant is required to file a petition (and pay the surcharge under § 1.17(t)) to correct a claim that does not comply with § 1.78(a)(2)(i) and (iii) or § 1.78(a)(5)(i) and (iii) is based upon the effect the informal claim has on the scheduling of the

application for publication, and not whether the informal claim is ultimately included in the patent application publication." 66 FR 67087, 67091 [emphasis added]

Accordingly, applicants did NOT intend their petition to be treated as a petition under 37 CFR 1.78, and did not attempt to comply with the requirements for such a petition.

Whether or not an amendment can be entered into the application at this time under 37 C.F.R. 1.312, applicants earnestly request that the decision to dismiss be reconsidered and the Petition granted, so that applicants can determine with the responsible USPTO Examiner how to best implement that decision in the instant application.

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Attachment 1

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Bib Data Sheet

CONFIRMATION NO. 4815

SERIAL NUMBER	FILING DATE	CLASS	GROUP ART UNIT	ATTORNEY DOCKET NO.						
09/932,013	08/17/2001	713	2132	A31510-072817-0139						
APPLICANTS David Barrington Everett, East Sussex, UNITED KINGDOM; Stuart James Miller, Berks, UNITED KINGDOM; Anthony David Peacham, Kent, UNITED KINGDOM; Ian Stephen Simmons, Cambs, UNITED KINGDOM; Timothy Philip Richards, Herts, UNITED KINGDOM; John Charles Viner, Windlesham, UNITED KINGDOM;										
** CONTINUING DATA THIS APPLICATION IS A CON OF 09/076,551 05/12/1998, new U.S. patent 6,317,832 WHICH CLAIMS BENEFIT OF 60/046,514 05/15/1997 AND CLAIMS BENEFIT OF 60/046,543 05/15/1997 AND A CON OF 09/023,057 02/12/1998, new U.S. patent 6,575,372										
** FOREIGN APPLICATIONS										
IF REQUIRED, FOREIGN FILING LICENSE GRANTED ** 08/14/2001										
Foreign Priority claimed 25 USC 119 (a-d) conditions met Verified and Acknowledged		<input type="checkbox"/> yes <input checked="" type="checkbox"/> no <input type="checkbox"/> yes <input checked="" type="checkbox"/> no <input type="checkbox"/> Met after Examiner's Signature: <i>Michael J. Smith</i> Initials: <i>MS</i>	STATE OR COUNTRY UNITED KINGDOM	SHEETS DRAWING 11 TOTAL CLAIMS 4 INDEPENDENT CLAIMS 4						
ADDRESS 21003										
TITLE Secure multiple application card system and process										
FILING FEE RECEIVED 790	FEES: Authority has been given in Paper No. _____ to charge/credit DEPOSIT ACCOUNT No. _____ for following: <table border="1"><tr><td><input type="checkbox"/> All Fees</td></tr><tr><td><input checked="" type="checkbox"/> 1.16 Fees (Filing)</td></tr><tr><td><input type="checkbox"/> 1.17 Fees (Processing Ext. of time)</td></tr><tr><td><input type="checkbox"/> 1.18 Fees (Issue)</td></tr><tr><td><input type="checkbox"/> Other</td></tr><tr><td><input type="checkbox"/> Credit</td></tr></table>				<input type="checkbox"/> All Fees	<input checked="" type="checkbox"/> 1.16 Fees (Filing)	<input type="checkbox"/> 1.17 Fees (Processing Ext. of time)	<input type="checkbox"/> 1.18 Fees (Issue)	<input type="checkbox"/> Other	<input type="checkbox"/> Credit
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US 20010056536A1

(19) **United States**(12) **Patent Application Publication**

Everett et al.

(10) Pub. No.: US 2001/0056536 A1

(43) Pub. Date: Dec. 27, 2001

(54) **SECURE MULTIPLE APPLICATION CARD SYSTEM AND PROCESS**

(76) Inventors: David Barrington Everett, East Sussex (GB); Stuart James Miller, Berks (GB); Anthony David Peacham, Kent (GB); Ian Stephen Simmons, Cambs (GB); Timothy Philip Richards, Herts (GB); John Charles Viner, Wiltshire (GB)

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30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

(21) Appl. No.: 09/932,013

(22) Filed: Aug. 17, 2001

Related U.S. Application Data

(63) Continuation of application No. 09/076,551, filed on May 12, 1998, now Pat. No. 6,317,832, which is a

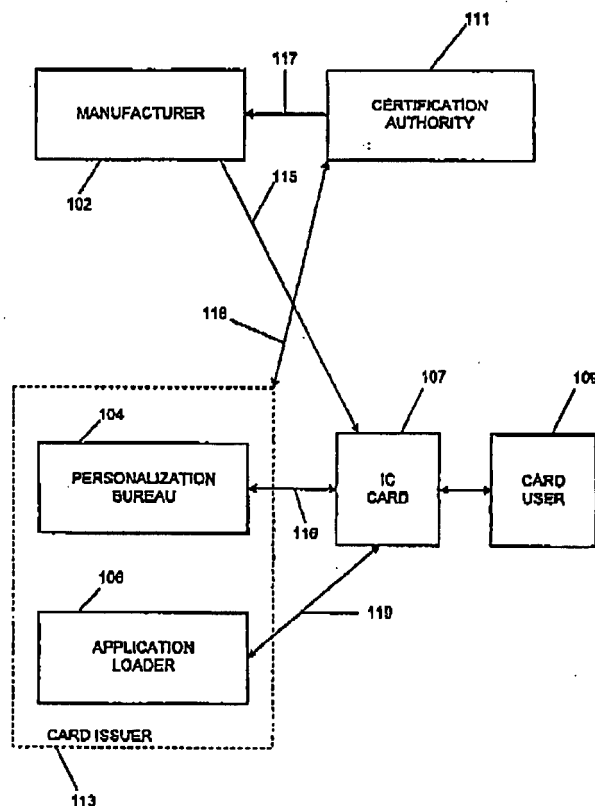
non-provisional of provisional application No. 60/046,514, filed on May 15, 1997 and which is a non-provisional of provisional application No. 60/046,543, filed on May 15, 1997 and which is a continuation of application No. 09/023,057, filed on Feb. 12, 1998.

Publication Classification(51) Int. Cl.⁷ H04L 9/00

(52) U.S. Cl. 713/172

(57) **ABSTRACT**

A secure multiple application card system and process is provided having secure loading and deleting capability by use of a Certification Authority and Personalization Bureau. The certification authority maintains the security of the system by requiring IC cards to be injected with its public key and a card identifier for uniquely identifying each card, by providing a personalization data block for each card, and by signing with its private key all applications to be loaded or deleted from the IC card.



Attachment 3

09/076,551 SECURE MULTIPLE APPLICATION CARD SYSTEM AND PROCESS

07-11-
2007::18:56:56**Parent Continuity Data**

Description	Parent Number	Parent Filing or 371 (c) Date	Parent Status	Patent Number
This application is a Continuation of	09/023,057	02-12-1998	Patented	6,575,372
Claims Priority from Provisional Application	60/046,514	05-15-1997	Expired	-
Claims Priority from Provisional Application	60/046,543	05-15-1997	Expired	-

Child Continuity Data

09/932,013 filed on 08-17-2001 which is Pending claims the benefit of 09/076,551
11/655,497 filed on 01-19-2007 which is Pending claims the benefit of 09/076,551
11/707,824 filed on 02-16-2007 which is Pending claims the benefit of 09/076,551
11/729,509 filed on 03-29-2007 which is Pending claims the benefit of 09/076,551
11/821,052 filed on null which is Pending claims the benefit of 09/076,551

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US006317832B1

(12) **United States Patent**
Everett et al.

(10) Patent No.: **US 6,317,832 B1**
(45) Date of Patent: **Nov. 13, 2001**

(54) **SECURE MULTIPLE APPLICATION CARD SYSTEM AND PROCESS**

(75) Inventors: David Barrington Everett, East Sussex; Stuart James Miller, Berks; Anthony David Pencham, Kent; Ian Stephen Simmons, Cambs; Timothy Philip Richards, Herts; John Charles Viner, Windlesham, all of (GB)

(73) Assignee: Mondex International Limited, London (GB)

(*) Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 0 days.

(21) Appl. No.: 09/076,551

(22) Filed: May 12, 1998

Related U.S. Application Data

- (63) Continuation of application No. 09/023,057, filed on Feb. 12, 1998.
(60) Provisional application No. 60/046,543, filed on May 15, 1997, and provisional application No. 60/046,514, filed on May 15, 1997.
(51) Int. Cl.⁷ H04L 9/00
(52) U.S. Cl. 713/172
(58) Field of Search 713/156, 166, 713/172, 187

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(List continued on next page.)

Primary Examiner—Tod Swann

Assistant Examiner—Matthew Smithers

(74) Attorney, Agent, or Firm—Baker Botts L.L.P.

(57) **ABSTRACT**

A secure multiple application card system and process is provided having secure loading and deleting capability by use of a Certification Authority and Personalization Bureau. The certification authority maintains the security of the system by requiring IC cards to be injected with its public key and a card identifier for uniquely identifying each card, by providing a personalization data block for each card, and by signing with its private key all applications to be loaded or deleted from the IC card.

10 Claims, 11 Drawing Sheets

